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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,224	11/08/2001	Frank Kopf	1813	5567

7590 10/18/2005  
Striker Striker & Stenby  
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EXAMINER

MACARTHUR, VICTOR L

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/009,224	Applicant(s) KOPF, FRANK	
	Examiner Victor MacArthur	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13, 14, 16, 17 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13, 14, 16, 17 and 19-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 7/11/2005 and 8/10/2005 have been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Lines 11-12 of the claim 28 recite "pin means... surrounding the spring element". Applicant has not pointed out where the amended claim is supported, nor does there appear to be a written description of the claim limitation in the application as filed. Note that applicant's pin (48) does not surround the spring element (16) but rather engages into it. The phrase "surrounding" should be replaced with --engaging within--.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claim 28, the word "means" (lines 10 and 11 of claim 28) is preceded by the word "pin" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). The phrase "means" should be deleted from the claim.

Further regarding claim 28, it is unclear what portions of the claim are meant to be intended use preamble and what if any are meant to positively limit the "device". In lines 1-2 it appears that the applicant is claiming "A device" intended to be used "for securing an add-on part to a substantially smooth drive shaft, having a one-piece...". It is unclear where or if the preamble ends and positive recitation of the device begins. It appears that the entire claim recites essential structure/steps (i.e. "a one piece slaving element" as recited in line 2 is essential to describe the "device" as positively recited in lines 9-10) and is necessary to give life, meaning and vitality to the claim. Therefore, the examiner has determined that the entire claim limits the invention such that the scope is narrowed by all phraseology therein. The examiner has considered the claims **in** combination (emphasis added). See MPEP 2111.02 and *Catalina Marketing International Inc. v. Coolsavings.com, Inc.*, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002). The examiner suggests deleting the word "for" from line 1 to overcome this rejection and improve claim clarity.

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Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 14, 16, 17 and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savage (U.S. Patent 4,245,957) in view of Delf (U.S. Patent 2,773,365):

Claim 13. Savage discloses (figs.1 and 2) a device for securing an add-on part (10) to a substantially smooth drive shaft (34), having a slaving element (42; 26, 28, 30), which is seated in a manner fixed against relative rotation on the drive shaft and transmits a rotary motion from the drive shaft to the add-on part, and having only one spring element (46), which axially secures the add-on part on the drive shaft, characterized in that the slaving element penetrates (through the center of the add-on part) the add-on part, and the spring element is braced directly on the slaving element and on the add-on part and thus axially fixes the add-on part on the drive shaft. Savage does not disclose that the slaving element is of one-piece construction. Delf teaches (fig.2) that it is very well known in the add-on part securing art for slaving units (13) to be of one-piece construction. One of ordinary skill would have readily recognized that one-piece construction of slaving units simplifies assembly by reducing the number of parts to be assembled. It has generally been recognized that one-piece construction, in place of separate

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elements fastened together, is a design consideration within the skill of the art. In re Kohno, 391 F.2d 959, 157 USPQ 275 (CCPA 1968); In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965). Accordingly, it would have been obvious to one of ordinary skill in the art to modify the Savage slaving unit to be of one piece construction, as taught by Delf, to simplify assembly since such practice is a design consideration within the skill of the art.

Claim 14. Savage discloses that the add-on part is clamped between the spring element and a portion (right portion of the slaving element) of the slaving element.

Claim 16. Savage discloses that the slaving element has a collar-shaped widening (50) on which the spring element is braced.

Claim 17. Savage discloses that the add-on part has recesses (recess in 10 receiving 50 and 30), through which the slaving element can be passed (in as much as the applicant's invention can) with its collar-shaped widening.

Claim 19. Savage discloses that the slaving element has a plate-shaped widening (26) of its diameter, at which the add-on part is braced.

Claim 20. Savage discloses that the slaving element has recesses (recesses on either side of 50) corresponding to the location of a collar-shaped widening (50).

Claim 21. Savage discloses that the spring element is a circular cup spring that is open on one side (in as much as the applicant's invention is).

Claim 22. Savage discloses that the spring element is secured on the add-on part against later twisting by means of a positioning pin (22). Note that pin 22 contributes to the securement of spring (46) even though it does not directly contact spring (46).

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Claim 23. Savage discloses that the add-on part to be secured is a vane wheel of a fan (col.2, ll.15-20).

Claim 24. Savage discloses that the slaving element is press-fitted onto the drive shaft (col.2, ll.55-60).

Claim 25. Savage discloses (figs.1 and 2) a device for securing an add-on part (10) to a substantially smooth drive shaft (34), having a slaving element (42, 26, 28, 30), which is seated in a manner fixed against relative rotation on the drive shaft and transmits a rotary motion from the drive shaft to the add-on part, and having a spring element (46), which axially secures the add-on part on the drive shaft, characterized in that the slaving element penetrates the add-on part, and the spring element is braced on the slaving element and on the add-on part and thus axially fixes the add-on part on the drive shaft, and also directly abuts against the slaving element and against the add-on part. Savage does not disclose that the slaving element is of one-piece construction. Delf teaches (fig.2) that it is very well known in the add-on part securing art for slaving units (13) to be of one-piece construction. One of ordinary skill would have readily recognized that one-piece construction of slaving units simplifies assembly by reducing the number of parts to be assembled. It has generally been recognized that one-piece construction, in place of separate elements fastened together, is a design consideration within the skill of the art. In re Kohno, 391 F.2d 959, 157 USPQ 275 (CCPA 1968); In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965). Accordingly, it would have been obvious to one of ordinary skill in the art to modify the Savage slaving unit to be of one piece construction, as taught by Delf, to simplify assembly since such practice is a design consideration within the skill of the art.

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Claim 26. Savage discloses (figs.1 and 2) a device for securing an add-on part (10) to a substantially smooth drive shaft (34), having a slaving element (42, 26, 28, 30) which is seated in a manner fixed against relative rotation on the drive shaft and transmits a rotary motion from the drive shaft to the add-on part, and having only on spring element (46), which axially secures the add-on part on the drive shaft, characterized in that the slaving element penetrates the add-on part, and the spring element is braced directly on the slaving element and on the add-on part and thus axially fixes the add-on part on the drive shaft, and that the spring element is embodied in one piece. Savage does not disclose that the slaving element is of one-piece construction. Delf teaches (fig.2) that it is very well known in the add-on part securing art for slaving units (13) to be of one-piece construction. One of ordinary skill would have readily recognized that one-piece construction of slaving units simplifies assembly by reducing the number of parts to be assembled. It has generally been recognized that one-piece construction, in place of separate elements fastened together, is a design consideration within the skill of the art. In re Kohno, 391 F.2d 959, 157 USPQ 275 (CCPA 1968); In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965). Accordingly, it would have been obvious to one of ordinary skill in the art to modify the Savage slaving unit to be of one piece construction, as taught by Delf, to simplify assembly since such practice is a design consideration within the skill of the art.

Claim 27. Savage discloses (figs.1 and 2) a device for securing an add-on part (10) to a substantially smooth drive shaft (34), having a slaving element (42, 26, 28, 30), which is seated in a manner fixed against relative rotation on the drive shaft and transmits a rotary motion from the drive shaft to the add-on part, and having a spring element (34), which axially secures the add-on part on the drive shaft, characterized in that the slaving element penetrates the add-on

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part, and the spring element is braced directly on the slaving element and on the add-on part and thus axially fixes the add-on part on the drive shaft, and in that the add-on part has positive form-locking engagement with the slaving element (in as much as the applicant's invention does) such that the add-on part positively interlocks (via 22, 24) with the slaving element in direct contact with the slaving element and embraces it. Savage does not disclose that the slaving element is of one-piece construction. Delf teaches (fig.2) that it is very well known in the add-on part securing art for slaving units (13) to be of one-piece construction. One of ordinary skill would have readily recognized that one-piece construction of slaving units simplifies assembly by reducing the number of parts to be assembled. It has generally been recognized that one-piece construction, in place of separate elements fastened together, is a design consideration within the skill of the art. In re Kohno, 391 F.2d 959, 157 USPQ 275 (CCPA 1968); In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965). Accordingly, it would have been obvious to one of ordinary skill in the art to modify the Savage slaving unit to be of one piece construction, as taught by Delf, to simplify assembly since such practice is a design consideration within the skill of the art.

***Allowable Subject Matter***

Claim 28 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraph, set forth in this Office action, assuming that it is the combination that is being claimed.

The prior art does not disclose or suggest a slaving element having a pin extending in an axial direction and engaging into the add-on part, while the add-on part has a pin extending in the same axial direction and engaging into the spring element.

### ***Response to Arguments***

Applicant's arguments with respect to the newly added claim limitations have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

Applicant's amendment (i.e., the newly added limitation "one-piece" in claims 13 and 25-27) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085.

The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

*VLM*

VLM

October 14, 2005

*Daniel P. Stodola*

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